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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,870	12/20/2001	Edward W. Knowlton	16904-760	2584

7590

10/21/2003

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EXAMINER
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GIBSON, ROY DEAN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/026,870

Applicant(s)

KNOWLTON, EDWARD W.

Examiner

Roy D. Gibson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 76,77,81-86 and 88-148 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 84,97-133 and 137-148 is/are allowed.
- 6) ☐ Claim(s) 76,77,81-83,85,86,88-96,134 and 136 is/are rejected.
- 7) ☐ Claim(s) 135 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Entry of Amendment***

Applicant's amendment filed on August 1, 2003, as Paper No. 9, is acknowledged. Claims 78-80 and 87 have been canceled, and claims 134-148 have been added by the applicant, thus claims 76-77, 81-86 and 88-148 are currently pending.

***Prior Rejections or Objections***

The following comments pertain to the rejections or objections in the most recent Office action, Paper No. 8, mailed on April 1, 2003. Rejections under Double Patenting and under 35 U.S.C. 102 and 103 are withdrawn, however, new grounds of rejection are presented below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 93 and 94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 93, in line 6, it is unclear what is meant by "different types of electromagnetic energy". It would appear that different "frequencies" or "wavelengths" are the intended differences being claimed.

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Claim 94 recites the limitation "first RF electrode" in line 2. There is insufficient antecedent basis for this limitation in the claim. The examiner suggests that the claim should depend from claim 86 to correct this.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 76, 77, 81-83, 85, 91-93, 134 and 136 are rejected under 35 U.S.C. 102(e) as being anticipated by Farin et al. (5,776,092).

As to claim 76, 77, 82-83 and 134, Farin et al. disclose a treatment apparatus comprising:

an energy delivery device (9); at least a first and second energy delivery member (laser member or non-RF member, # 15) and (ultrasonic member, # 4 or first RF electrode # 10); and a cooling member [lumen for irrigation or rinsing fluid which inherently can cool the tissue and the tip of the device of energy delivery surface (3) and which is configured to deliver a controllable amount of fluid] coupled to the energy delivery device (Figures 5, 6 and 7, col. 2, lines 25-45, col. 4, lines 23-60, col. 5, lines 43-62 and col. 6, lines 28-37).

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*for movement of the operator not a feedback*  
As to claims 81, 85, 91-93 and 136, Farin et al. further disclose a feedback control coupled to the first RF electrode to facilitate its operation (col. 6, lines 2-8) along with the cooling detailed above.

*→ 103 w/ Teaching of feedback*

Claims 76, 77, 82, 83, 85, 86, 91-94, 134 and 136 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosen et al. (5,556,377).

As to claim 76, 77, 82-83 and 134, Rosen et al. disclose a treatment apparatus comprising:

an energy delivery device (4); at least a first and second energy delivery member (laser member or non-RF member, # 1116) and (first RF/MW electrode); and a cooling member [lumen for irrigation or rinsing fluid which inherently can cool the tissue and the tip of the device of energy delivery surface (tip shown in Figure 17) and which is configured to deliver a controllable amount of fluid] coupled to the energy delivery device (col. 2, lines 55-65, col. 5, lines 15-25, col. 9, lines 28-52, col. 11, lines 4-64 and → col. 13, lines 1-31).

As to claims 85, 86, 91-94 and 136, Rosen et al. further disclose a control coupled to the first RF/MW electrode to facilitate its operation (also inherent in the device) along with the cooling detailed above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 88, 95, 89, 90 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen et al.

As to claims 88 and 95, Rosen et al. teach the substitution of one laser member for an RF/MW member, and the examiner maintains that it would have been obvious to a skillful artisan to substitute a second laser device as well by an RF/MW member.

As to claims 89, 90 and 96, the examiner maintains that it is well known to substitute a mono-polar RF or MW device with an electrode configuration for a bipolar configuration.

### ***Allowable Subject Matter***

Claims 84, 97-133 and 137-148 allowed.

Claim 135 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 703-308-3520. The examiner can normally be reached on M-F, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

  
Roy D. Gibson  
Primary Examiner  
Art Unit 3739

October 15, 2003